

REMARKS/ARGUMENTS

This Amendment is filed in response to a final Official Action on a second Request for Continued Examination (RCE), and concurrent with a third RCE, for the above-identified patent application. The Official Action rejects Claims 52-59, 62, 66 and 67 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Official Action then maintains the prior rejection of all of the pending claims, namely Claims 1-15, 18-34, 37-48, 51-59 and 62, under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0173295 to Nykanen, in view of U.S. Patent No. 6,782,253 to Shteyn et al. As explained below, however, Applicants respectfully submit that Claims 52-59, 62, 66 and 67 are directed to statutory subject matter, and that the claimed invention is patentably distinct from Nykanen and Shteyn, taken individually or in any proper combination. Nonetheless, Applicants have amended various ones of the claims to further clarify the claimed invention, including adding new dependent Claims 68-70. In view of the amended claims and remarks presented below, Applicants respectfully request reconsideration and allowance of all of the pending claims of the present application.

A. The Claims are Statutory

The Official Action rejects computer program product Claims 52-59, 62, 66 and 67 for being directed to non-statutory subject matter. More particularly, the Official Action alleges that computer program product Claims 52-59, 62, 66 and 67 are actually software or a computer program. Applicants respectfully disagree, however, and submit that at least the recitation “computer-readable storage medium” may not in fact be reasonably interpreted as just software. Not only would one skilled in the art interpret at least the aforementioned recitation as constituting statutory subject matter, the Interim Guidelines cited in the Official Action recognize a “computer-readable medium” as being statutory. *Id.* at page 4, citing *Interim Guidelines for Examination of Patent Applications for Patentable Subject Matter Eligibility*, Annex IV.

More generally, Applicants note that the computer program product of Claims 52-59, 62, 66 and 67 includes a computer-readable storage medium having computer-readable code

portions stored therein, those portions including a number of executable portions. And as explained in the aforementioned *Interim Guidelines*, “[w]hen functional descriptive material [(executable code portions)] is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” *Interim Guidelines*, Annex IV, page 50 (emphasis added). *See also id.*, Annex IV (a), page 52. Nonetheless, to further clarify the storage medium of Claims 52-59, 62, 66 and 67, Applicants have amended Claims 52-59, 62, 66 and 67 so as to be directed to the computer-readable storage medium.”

For at least the foregoing reasons, Applicants respectfully submit that the rejection of Claims 52-59, 62, 66 and 67 for being directed to non-statutory subject matter is overcome.

B. The Claims are Patentable

According to one claimed aspect of the present invention, amended independent Claim 1 provides a mobile station including a context engine and a communication manager. As recited, the context engine is configured to store context-related information, the context-related information having been created based upon at least a portion of one or more conditions measured by at least one sensor. In this regard, the context engine is also configured to manage an exchange of the context-related information with one or more context consumers. In turn, then, the communication manager is configured to communicate with one or more context consumers to receive one or more context rules and exchange context-related information, with one or more of those context consumer(s) located external to the mobile station. In this regard, the context rule(s) include one or more condition values relating to at least a portion of context-related information, and further include one or more actions to be performed. The mobile station further includes a script engine configured to execute at least a portion of one or more context rules, including being configured to perform at least a portion of respective action(s), based on a comparison of the respective at least one condition value and the condition(s) measured by the sensor(s).

The Official Action concedes that Nykanen does not reach or suggest the recited script

engine, but alleges that Shteyn discloses this feature, and that it would have been obvious to one skilled in the art to modify Nykanen per Shteyn to teach the claimed invention. In this regard, as cited in the Official Action, Shteyn discloses a mobile device maintaining multiple user profiles set up for different contexts (e.g., work, shopping, at home, etc.). As disclosed, an active user profile may be switchably selected from among the multiple user profiles in response to explicit user selection, or in response to a signal from the environment. It is this selection of an active user profile in response to an environment signal that the Office appears to correspond to the recited script engine (i.e., performing an action based on a comparison of a condition value and a measured condition).

As previously explained, in contrast to amended independent Claim 1, neither Nykanen nor Shteyn, taken individually or in any proper combination, teaches or suggests a communication manager configured to communicate with an external context consumer to not only exchange context-related information, but to also receive a context rule (condition value and action) that a script engine is configured to execute. As suggested above, the Official Action cites Nykanen for disclosing the communication manager communicating with an external context consumer to receive a context rule. *See* Official Action of Nov. 20, 2008, pages 3-4, *citing* Nykanen, paragraphs 0061, and 0131-0132. Cited paragraph 0061 of Nykanen discloses a security measure for registering programs to access the user's private data, this registration being asserted as a context rule; but even given this disclosure, nowhere does Nykanen teach or suggest receiving a context rule from an external context consumer, similar to amended independent Claim 1. And cited paragraphs 0131-0132 of Nykanen disclose context inference engines in a network server and wireless device, but again, nowhere does Nykanen teach or suggest that either engine receives rules from an external context consumer, similar to amended independent Claim 1.

Similar to Nykanen, Shteyn also does not teach or suggest a communication manager configured to communicate with an external context consumer to receive a context rule (condition value and action) that a script engine is configured to execute. As indicated above, the Office appears to cite selection of a user profile in response to an environment signal as corresponding to a script engine executing a context rule. But even given this disclosure, Shteyn

does not teach or suggest receiving that asserted context rule (condition value and action) from an external context consumer, as per amended independent Claim 1.

For at least the foregoing reasons, Applicants respectfully submit that amended independent Claim 1, and by dependency Claims 2-15, 18, 19 and 63, is patentably distinct from Nykanen, in view of Shteyn. Applicants also respectfully submit that amended independent Claims 20, 40, 52 and 68 recite subject matter similar to amended independent Claim 1, including the aforementioned communication with an external context consumer to receive a context rule (condition value and action) for execution. Accordingly, Applicants respectfully submit that amended independent Claims 20, 40, 52 and 68, and by dependency Claims 21-34, 37-39, 41-48, 51, 53-59, 62, 64-67, 69 and 70, are also patentably distinct from Nykanen, in view of Shteyn for at least the same reasons given above with respect to amended independent Claim 1. Applicants therefore respectfully submit that the rejection of Claims 1-15, 18-34, 37-48, 51-59 and 62 under 35 U.S.C. § 103(a) as being unpatentable over Nykanen, in view of Shteyn is overcome.

Application No.: ~~10/817,401~~10/817,401
Amendment Dated March 20, 2009
Reply to Official Action of November 20, 2008

CONCLUSION

In view of the amended claims and remarks presented above, Applicants respectfully submit that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicants' undersigned attorney in order to resolve any remaining issues.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



Andrew T. Spence
Registration No. 45,699

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111
LEGAL02/31206071v1

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON MARCH 20, 2009.